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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,374	01/29/2004	Avi Ashkenazi	39780-1216 RIC1D1	4761
35489	7590	10/24/2006		
HELLER EHRMAN LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506				
EXAMINER HADDAD, MAHER M				
ART UNIT			PAPER NUMBER	
1644				

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/767,374

Applicant(s)

ASHKENAZI ET AL.

Examiner

Maher M. Haddad

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 03 October 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 54, 55 and 57.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: 1. Claims 54-55 and 57 stand rejected to under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and/or substantial asserted utility or a well established utility for the same reasons set forth in the previous Office Action mailed 5/4/06.

Applicant's arguments, filed 10/3/06, have been fully considered, but have not been found convincing.

Applicant argues that the overall disclosure provided in the specification clearly establisheds an association between PRO362 and inflammation. Applicant directs the Examiner's attention to the end of Example 9, wherein it discloses that it is likely that PRO362 would have elevated expression in inflammatory human disease, such as inflammatory bowel disease and other inflammatory disease of the gut. Further Applicant draws the Examiner's attention to the specification on page 48, lines 13-31, for support that one of ordinary skill would clearly understand that PRO362 can be used as a diagnostic marker of immune related diseases, in particular inflammatory diseases. Applicant contends that such diagnostic utility does not depend on whether PRO362 is an anti-inflammatory or pro-inflammatory molecule. As long as it show elevated expression in inflammatory conditions, it can be used to diagnose such conditions.

However, besides the speculative statement at the end of Example 9 of the specification, no actual data showing that PRO362 polynucleotide is more highly expressed in inflammatory disease compared to normal healthy control subject. In addition, there is no further supporting evidence to indicate that the claimed polypeptide encoded by the polynucleotide is also differentially expressed in the inflammatory disease when compared to healthy control for one skilled in the art to use it as a diagnostic marker. Accordingly, the skilled in the art would conclude that use of PRO362 polypeptide as a diagnostic marker is not supported by substantial asserted utility or a well-established utility. The argument presented evidence that instant specification provides a mere invitation to experiment, and not readily available utility. There is no description in the specification to that would indicate a correlation with higher expression levels of the message to the PRO362 polypeptide. It remains that, there is no information on the record as to whether the claimed polypeptide is expressed in inflammatory diseases.

2. Claims 54-55 and 57 stand rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and/or substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention so that it would operate as intended without undue experimentation. .



MAHER M. HADDAD
PATENT EXAMINER